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Paper No. 9
RLS/JMP

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lange Uhren GmbH

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Serial No. 75/766,264

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Eric P. Schellin of Schellin & Associates for Lange Uhren GmbH.

Monique C. Miller, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Simms, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Lange Uhren GmbH (applicant), a corporation of the Federal Republic of Germany, has appealed from the final refusal of the Trademark Examining Attorney to register the mark SAXONIA for chronometric instruments; namely, watches,

parts of watches and watchbands.[1] The Examining Attorney has refused registration under Section 2(d) of the Act, 15 U.S.C. § 1052(d), on the basis of three registrations, two of which are held by the same entity. These registrations are Registration No. 1,468,975, issued December 15, 1987 (Sections 8 and 15 affidavits accepted and acknowledged, respectively) for the mark SAXONY for jewelry; Registration No. 1,603,647, issued June 26, 1990 (Sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed) covering the mark SAXON for jewelry of precious metals and gems; and Registration No. 1,605,091, issued July 3, 1990 (Sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed) covering the mark SAXON for custom designing of jewelry for others. The last two registrations are held by the M.B. Saxon Company. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

Briefly, applicant argues that its mark is used on a worldwide basis in connection with extremely expensive watches. It is applicant's position that, while

[1] Application Serial No. 75/766,264, filed August 2, 1999, under Section 44(e) of the Trademark Act, based upon ownership of German Registration No. 2,084,408, issued September 11, 1994. The German registration indicates that it expires on September 30, 2004.

confusion might arguably be likely if applicant's mark was SAXON or SAXONY, here applicant's mark is SAXONIA, which is different. Also, applicant notes its goods are watches and not jewelry.

We agree with the Examining Attorney, however, that applicant's mark is so similar to the registered marks SAXON and SAXONY that, as used on watches, watchbands and parts of watches, confusion is likely.

The determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood-of-confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the goods, it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection

therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. *In re International Telephone and Telegraph Corp.,* 197 USPQ 910 (TTAB 1978). Further, the identifications of goods in the application and the cited registration control the comparison of the goods. *See Canadian Imperial Bank v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)["[T]he question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be."]; and *In re Elbaum,* 211 USPQ 639 (TTAB 1981). Thus, we may not consider applicant's watches to be only very expensive ones, as it has argued, and instead must consider applicant's goods and the goods and services in the cited registrations to encompass all possible price points.

With respect to the marks, applicant's mark SAXONIA is very similar in sound, appearance and connotation to the registered marks SAXON and SAXONY. With regard to the connotation or meaning of the respective marks, the Examining Attorney has made of record evidence indicating

that "Saxonia" names a region of Germany.[2] Indeed, the Examining Attorney maintains that Saxonia appears to be synonymous with Saxony, an area or region in Germany. Suffice it to say that we agree with the Examining Attorney that the marks SAXONIA and SAXONY and SAXON have the same or similar overall commercial impressions.

With respect to the goods, the Examining Attorney has made of record a number of exhibits concerning the relationship of jewelry, watches and the custom design of jewelry. These include store catalogs showing that the same retail stores sell both jewelry and watches. Also, the record contains numerous third-party registrations covering both watches on the one hand and jewelry (or the custom design of jewelry) on the other. The Examining Attorney even notes that in some of these registrations watches are considered a type of jewelry ("jewelry, namely…watches"). The Examining Attorney's position, therefore, that registrants' goods could encompass applicant's watches seems well taken. Also, excerpts of articles from the Nexis database indicate that the same stores sell both watches and jewelry (and custom design jewelry). It is clear that the same class of purchasers

[2] In her final office action, the Examining Attorney withdrew a refusal that applicant's mark was primarily geographically

may be exposed to the marks of the registrants as well as to applicant's mark. See, for example, *In re Leonard S.A.,* 2 USPQ2d 1800 (TTAB 1987) and *Monocraft, Inc. v. Leading Jewelers Guild,* 173 USPQ 506 (TTAB 1972).

Accordingly, we conclude that purchasers, aware of SAXON and SAXONY jewelry (as well as SAXON custom design of jewelry) who then encounter applicant's SAXONIA watches, watchbands and parts of watches are likely to believe that the jewelry, watches, watchbands, etc. and the custom design services all come from or are sponsored or endorsed by the same source. This is especially true considering the recollection of the average purchaser, who may have a fallible memory and retain only a general, rather than a specific, impression of a trademark. Of course, if we had any doubt about the issue, that doubt would have to be resolved in favor of the prior registrants.

Decision: The refusal of registration with respect to each of the cited registrations is affirmed.

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descriptive under Section 2(e)(2) of the Act, because it refers to a region in Germany.